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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: ) Art Unit: 1643  
                          ) )  
Matthew Todd GILLISPIE et al. ) Examiner:  
                          ) )  
Serial No.: 09/030,061 ) Washington, D.C.  
                          ) )  
Filed: February 25, 1998 ) April 26, 2001  
                          ) )  
For: OSTEOCLASTGENIC... ) Docket No.: GILLISPIE=1

**RESPONSE TO RESTRICTION REQUIREMENT**

Honorable Commissioner for Patents  
Washington, D.C. 20231

Sir:

The Office Action of March 26, 2001, primarily in the nature of a requirement for restriction, has been carefully reviewed.

Restriction has been required between what the examiner deems to be two patentably distinct inventions, namely:

Group I, drawn to an osteoclastgenic inhibitory composition, and presently comprising claims 1-6 and 8-10; and

Group II, drawn to a method for treating a disease associated with extensive osteoclast formation or activity, and presently comprising claims 11-27.

Applicants hereby respectfully and provisionally elect with traverse Group I, presently comprising claims 1-6 and 8-10.

The requirement is respectfully traversed on the basis of the second paragraph of MPEP §803 which requires that there be a "serious burden" in order to make a restriction requirement, even if the requirement is otherwise correct. In the present case, the method of using is closely tied to the product, with the method of using claims reciting the same parameters as the product claim. Under the circumstances, and in order to do a complete search of the product, it would also be necessary to search the method as well, and therefore there would be no "serious burden" in examining the method claims even though they are separately classified.

Withdrawal of the restriction requirement is accordingly respectfully requested.

Favorable consideration and examination of all the claims on the merits are respectfully requested.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.  
Attorneys for Applicant(s)

By: 

Allen C. Yun  
Reg. No. 37,971

624 Ninth Street, N.W.  
Washington, D.C. 20001  
Telephone No.: (202) 628-5197  
Facsimile No.: (202) 737-3528  
ACY:pr